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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,085	04/30/2007	Mario Polegato Moretti	293046US0PCT	6215
22850	7590	02/08/2011	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			MOHANDESI, JILA M	
			ART UNIT	PAPER NUMBER
			3728	
			NOTIFICATION DATE	DELIVERY MODE
			02/08/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/585,085	Applicant(s) MORETTI ET AL.	
	Examiner JILA M. MOHANDESI	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-60 is/are pending in the application.
- 4a) Of the above claim(s) 55-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-54 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/06/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claim 55-59 drawn to an invention nonelected with traverse in the reply filed on 04/27/2010. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Rejection to claims 31-54 and 60 under 35 U.S.C. 112, second paragraph has been overcome in view of the present amendment.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 31-54 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polegato (Pub. No. US 2002/0100187) in view of Rechlicz et al. (US 5,032,450). Polegato discloses a waterproof breathable sole for shoes (see Figures 1 and 3bis), comprising, for at least part of its extension, at least two structural layers (inasmuch as applicant has disclosed what is meant by “supporting structure” in the claims, the two structural layers of Polegato provide supporting structure in that they provide added cushioning), wherein a first structural layer is lower layer (13) provided with a supporting structure so as to form a tread, and a second structural layer is an upper microporous layer (hydrophobic material 222b and hydrophilic material 222c, see Figure 3bis and paragraphs [0068] thru [0071]) that is permeable to water vapor, said lower layer having two, upper and lower surfaces and portions that are open onto said upper layer (See Figure 1), the upper layer having upper and lower surfaces and portions. Polegato is silent about at least one of the two surfaces of said upper microporous layer comprising a coating formed by plasma deposition treatment for forming a waterproof breathable material. Rechlicz et al. discloses that it is desirable to provide a moisture vapor permeable coating of hydrophobic polymer of polysiloxane on one side of a sheet of microporous matrix material of polylofin and siliceous filler, having interconnecting pores to make the membrane substantially impermeable to liquid water and permeable to moisture vapor. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a microporous matrix material coated with moisture vapor permeable coating of hydrophobic polymer of polysiloxane as the upper

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layer of the sole of Polegato as taught by Rechlicz et al. to make the upper layer substantially impermeable to liquid water and permeable to moisture vapor. The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

With respect to claims 32-34 and the upper surface, lower surface or both the lower and upper surface of the upper layer/membrane being provided with the coating, this would be an obvious to one of ordinary skill in the art based on the cost of manufacturing.

With respect to claims 42-54, the polysiloxane coating is applied on the microporous material by spreading (column 14, lines 10-20). Rechlicz does not specifically disclose the polysiloxane coating is obtained by way of a plasma deposition treatment. However, this is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Rechlicz is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The coated article comprises a moisture vapor permeable coating of polysiloxane on one side of the sheet of microporous material (abstract). The microporous material is a matrix of polyolefin and siliceous filler, having interconnecting pores. The microporous material has a thickness of 30 to 400 microns, an average pore size of 0.02 to 0.5 microns/micrometers and porosity in the range from 60 to 70% (column 3, lines 35-40; column 10, lines 20-22; and 30-35). Even though product-by-

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process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 227 USPQ 964,966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. In re Marosi, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Rechlicz et al.

With respect to claims 36-38 and 60, Rechlicz et al. discloses that the microporous material can be from a variety of materials. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the material of the upper layer since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

7. Applicant's arguments filed 12/21/2001 have been fully considered but they are not persuasive.

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8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10. The art rejections over Rechlicz have been maintained for the following reasons. Applicants contend that the coated article of the prior art is structurally different from the presently claimed multilayer article because Rechlicz fails to teach a plasma deposited ultrathin film of a polysiloxane set out in the claim. Applicants then goes on that the plasma deposition has effects in that it allows for a control in the thickness of the waterproof coating, properties of the coating and also to have coating which is not coupled to the upper microporous layer with glue. However, nothing in the claim is specific about the coating which is not coupled to the upper microporous layer with glue. Even if the claim is amended, the amendment does not render the claim unobvious over

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the prior art. Rechlicz discloses the coated article comprising a microporous substrate and a polysiloxane coating on the surface of the microporous substrate. Applicant also mentions that the plasma deposition can provide an ultrathin bonded layer of polymer deposited on the upper layer. The fact that the microporous substrate has a thickness of 134 microns (table V) implies that the polysiloxane coating would have a thickness less than 134 microns. This is within the claimed range. Applicants also mention that the adhesion between the upper layer and the coating itself is extremely strong due to the chemical interaction between the layers which occurs as a result of the plasma deposition and adhesion bonding strength of the plasma deposited film are not identical to those of the film formed from conventional coating methods. However, none of these special features which are resulted from the plasma deposition treatment have been incorporated into the claim to show the unobvious difference between the claimed product and the prior art product. Accordingly, the art rejections are maintained.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JILA M. MOHANDESI whose telephone number is (571)272-4558. The examiner can normally be reached on MONDAY-FRIDAY 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey YU can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

JMM
02/02/2011